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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,325	12/10/2001	Bryan C. Dunkeld	KOP 2001-I	4756
23694	7590	10/12/2006	EXAMINER	
J. NICHOLAS GROSS, ATTORNEY 2030 ADDISON ST. SUITE 610 BERKELEY, CA 94704			CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/016,325	DUNKELD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sara Chandler	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 December 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-58 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .                                                        | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 53, drawn to a system and method for distributing digital assets across a network, classified in class 707, subclass 10.
- II. Claims 14-21 and 54, drawn to a system and method for introducing digital assets into an electronic network distribution system, classified in class 705, subclass 57.
- III. Claims 22-27 and 55, drawn to a system and method for exchanging digital assets over a network, classified in class 707, subclass 203.
- IV. Claims 38-52 and 56, drawn to a system and method for managing transfers of digital assets over a network, classified in class 707, subclass 200.
- V. Claim 57, drawn to a method of providing a digital asset for distribution, classified in class 705, subclass 56.
- VI. Claim 58, drawn to a method of distributing a digital asset within an electronic network, classified in class 705, subclass 51.

The following inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable.

Inventions I and II: In the instant case, subcombination II has separate utility such as processing administration information for said digital asset, including an asset identifier and a rights-holder identifier. See MPEP § 806.05(d).

Inventions I and III: In the instant case, subcombination I has separate utility such as a third management server coupled to the network, said third management server being adapted to track transfers of said digital asset over the network and to generate tracking records associated with said transfers. See MPEP § 806.05(d):

Inventions I and IV: In the instant case, subcombination IV has separate utility such as a separate instantiation of said digital asset is created for each transfer occurring over the network. See MPEP § 806.05(d).

Inventions I and V: In the instant case, subcombination V has separate utility such as providing a serial number for said digital asset, said serial number being uniquely identified with a first introduction of digital asset for distribution within said electronic network.. See MPEP § 806.05(d).

Inventions I and VI: In the instant case, subcombination VI has separate utility such as providing an index of digital assets wherein said index includes a list of one or more locations for said digital assets, terms of use of said digital assets and category information for said digital assets. See MPEP § 806.05(d).

Inventions II and III: In the instant case, subcombination II has separate utility such as posting said modified version of said digital asset to a location suitable for download by said peer devices from the electronic network distribution system. See MPEP § 806.05(d).

Inventions II are IV: In the instant case, subcombination II has separate utility such as processing administration information for said digital asset, including an asset identifier and a rights-holder identifier. . See MPEP § 806.05(d).

Inventions II and V: In the instant case, subcombination V has separate utility such as providing a serial number for said digital asset, said serial number being uniquely identified with a first introduction of digital asset for distribution within said electronic network. See MPEP § 806.05(d).

Inventions II and VI: In the instant case, subcombination VI has separate utility such as providing an index of digital assets wherein said index includes a list of one or more locations for said digital assets, terms of use of said digital assets and category information for said digital assets. See MPEP § 806.05(d).

Inventions III and IV: In the instant case, subcombination IV has separate utility such as a first software routine executing on said management computer, said first software routine being adapted to prepare a digital asset for transfer over the network in accordance with a set of distribution rules. See MPEP § 806.05(d).

Inventions III and V: In the instant case, subcombination V has separate utility such as providing a serial number for said digital asset, said serial number being uniquely identified with a first introduction of digital asset for distribution within said electronic network. See MPEP § 806.05(d).

Inventions III and VI: In the instant case, subcombination VI has separate utility such as providing an index of digital assets wherein said index includes a list of one or

more locations for said digital assets, terms of use of said digital assets and category information for said digital assets. See MPEP § 806.05(d).

Inventions IV and V: In the instant case, subcombination V has separate utility such as providing a serial number for said digital asset, said serial number being uniquely identified with a first introduction of digital asset for distribution within said electronic network. See MPEP § 806.05(d).

Inventions IV and VI: In the instant case, subcombination VI has separate utility such as providing an index of digital assets wherein said index includes a list of one or more locations for said digital assets, terms of use of said digital assets and category information for said digital assets. See MPEP § 806.05(d).

Inventions V and VI: In the instant case, subcombination VI has separate utility such as providing an index of digital assets wherein said index includes a list of one or more locations for said digital assets, terms of use of said digital assets and category information for said digital assets. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to

provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner has not contacted the applicant for election over telephone due to the complex nature of the election/restriction requirement (see MPEP §812.01 (R-3)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



JAGDISH N. PATEL  
PRIMARY EXAMINER